

REMARKS

I. Introduction

Claims 15-29 are pending and being considered in the present application. In view of the following remarks, it is respectfully submitted that all of the pending claims are allowable, and reconsideration is respectfully requested.

Applicants note with appreciation the acknowledgement of the claim to foreign priority and the indication that all copies of the certified copies of the priority documents have been received.

Applicants thank the Examiner for considering the previously filed Information Disclosure Statement, PTO-1449 paper, and cited references.

II. Rejection of Claims 15 to 18 and 25 to 29 Under 35 U.S.C. § 102(b)

Claims 15 to 18 and 25 to 29 are rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent Application Publication No. 2001/0015577 (“Rueger 577”).

In order for a claim to be anticipated under 35 U.S.C. §102, a single prior art reference must disclose each and every element of the claim in exactly the same way. *Lindeman Maschinenfabrik v. Am. Hoist and Derrick*, 730 F.2d 1452, 1458 (Fed. Cir. 1984); MPEP §2131.

Claim 15 relates to a method for operating an actuator and recites “monitoring a correct functioning of the ohmic resistance; and outputting a fault signal upon detection of a malfunction.” The Office Action cites only the Abstract section and Figure 1 of Rueger 577 as assertedly disclosing these features of claim 15.

Neither of the cited portions of Rueger 577 discloses, or even suggests, “monitoring a correct functioning of the ohmic resistance.” Rueger 577 generally discloses that “the value (R) of the ohmic resistor is determined at certain times, and the type and/or temperature of the capacitive element is deduced on the basis of that value of the resistor.” Rueger 577 at par. 4. Determining the resistance value or using that value to determine temperature of a capacitive element does not disclose “monitoring a correct functioning of the ohmic resistance.”

Further, neither of the cited portions of Rueger 577 discloses, or even suggests, “outputting a fault signal upon detection of a malfunction.” Rueger 577 generally discloses “an analyzer 140 is connected in parallel to capacitive element 100a and ohmic

resistor 100b. This analyzer exchanges various quantities with control unit 130.” Rueger 577 at par. 19. This neither discloses “a fault signal” nor “detection of a malfunction.” Rueger 577 generally discloses that if there is a “malfunction of one of the components, a situation may occur where the controller is constantly in one certain position because the controller is no longer being discharged or it cannot be discharged any longer. To permit a suitable discharge of the capacitive element in this case, resistor 100b is connected in parallel . . . [so that the discharge period does not reach] the maximum period of time available until the valve must be securely closed in order not to damage the engine.” Rueger 577 at par. 23 and 24. This discloses neither “a fault signal” nor “detection of a malfunction.”

Accordingly, Rueger 577 does not disclose, or even suggest, all of the features of claim 15, so that Rueger 577 does not anticipate claim 15.

Claims 16 to 18 ultimately depend from claim 15 and therefore include all of the features recited in claim 15. It is therefore respectfully submitted that Rueger 577 does not anticipate these dependent claims for at least the same reasons as claim 15.

Claims 25, 28, and 29 include subject matter analogous to that of claim 15 discussed above, so that Rueger 577 does not anticipate any of these claims for at least essentially the same reasons set forth above in support of the patentability of claim 15.

Claims 26 and 27 depend from claim 25 and therefore include all of features recited in claim 25. It is therefore respectfully submitted that Rueger 577 does not anticipate either of these dependent claims for at least the same reasons as claim 25.

Withdrawal of this anticipation rejection it therefore respectfully requested.

III. Rejection of Claims 19 to 24 Under 35 U.S.C. § 103(a)

Claims 19 to 24 are rejected under 35 U.S.C. 103(a) as allegedly unpatentable over Rueger 577 in view of European Patent Application Publication No. 1 139 445 (“Rueger 445”).

To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. M.P.E.P. §2143. As discussed below, the Office Action fails to show how the cited prior art teaches or suggests all of the elements of the rejected claims and, therefore, has not established a *prima facie* case of obviousness.

Claims 19 to 24 ultimately depend from claim 15, and are therefore allowable for at least the same reasons as claim 15 since Rueger 445 does not, and was not asserted to, cure the deficiencies of Rueger 577 set forth above with respect to claim 15.

Additionally, contrary to the Office Actions' assertion, Rueger 445 fails to disclose or suggest "monitoring a correct functioning of the capacitative element" as provided for in the context of claim 19. Rueger 445 may generally disclose "diagnosing a fault in a system utilizing a piezoelectric element," where "[t]he system is preferably a fuel injection system." Rueger 445 at Abstract. However, Rueger 445 does not disclose or even suggest the feature of "monitoring a correct functioning of the capacitative element." For at least this additional reason, the combination of Rueger 577 and Rueger 445 does not render unpatentable claim 19 or its dependent claims 20 to 24.

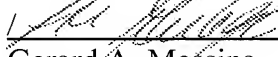
Withdrawal of this obviousness rejection is therefore respectfully requested.

CONCLUSION

In view of the foregoing, it is respectfully submitted that all of claims 15 to 29 are allowable. It is therefore respectfully requested that the rejections be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

Respectfully submitted,

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